AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Takashi NAIKI

Serial No.: 09/900,701

Filed: July 5, 2001

For: A PORTABLE INFORMATION APPARATUS HAVING COMMUNICATIONS TOOLS, A CONTROL SYSTEM FOR CONTROLLING SUCH PORTABLE INFORMATION APPARATUS, AND AN APPARATUS HAVING SUCH CONTROL SYSTEM

Art Unit: 2684

Examiner: Angelica Perez

Confirmation No. 3950

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Respectfully submitted,

HOGAN & HARTSON L.L.P.

Date: April 11, 2005

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APPEAL BRIEF

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Dear Sir:

This is an Appeal from the Examiner's Final Rejection of Claims 1-12. The Final Rejection issued on July 7, 2004 and the Notice of Appeal was received in the Patent and Trademark Office on January 11, 2005. The Appeal Brief was therefore initially due on March 11, 2005. A petition for a one-month extension of the period for response is enclosed, extending the time for filing the opening brief to April 11, 2005. Hence, this appeal brief is timely filed. The Commissioner is authorized to charge any deficiency in any fee or credit any excess payment to Deposit Account No. 50-1314.

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REAL PARTY IN INTEREST

The real party in interest is Rohm Co., LTD.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1-12 were originally pending in the present application. In the response to the Final Office Action dated July 7, 2004, Claims 1-2 were cancelled without prejudice. Therefore, this Appeal is directed to the final rejection of Claims 3-12, as originally filed, a copy of which appears as an Appendix to this Appeal Brief.

STATUS OF AMENDMENTS

An amendment under 37 C.F.R. §1.116 was filed on October 7, 2004 in response to the Final Office Action of July 7, 2004. According to an Advisory Action which subsequently issued on December 2, 2004, the amendments proposed in the Amendment under 37 C.F.R. §1.116 were not entered. However, the request for reconsideration was apparently considered, as the Applicant's arguments do not place the application in condition for allowance.

SUMMARY OF INVENTION

The present invention relates to a portable information apparatus having communications tools along with a control section connected with a wireless transmission/reception section, operation section, and display section for controlling overall actions of the portable information apparatus. The portable information apparatus includes a reception means within the wireless transmission/reception section for receiving a communication prohibition signal and/or a communication permission signal transmitted from an external facility. In accordance with receipt

of the communication prohibition signal and/or communication permission signal, enabling/disenabling of the transmission functions of the wireless transmission/reception section is set. *(See, Specification, page 11, line 17 to page 13, line 2).*

The communication prohibition signal and/or the communication permission signal are/is transmitted from a transmitter installed at a location where transmissions of electromagnetic waves from the portable information apparatuses are prohibited. *(See, Specification, page 13, lines 3-9).*

Thus, according to one aspect of the present invention, only transmission functions of the of the wireless transmission/reception section can be disenabled in proximity to electromagnetically susceptible apparatuses, such as a cardiac pacemaker, which can undergo malfunctions under strong ambient electromagnetic waves in response to an announcement, such as, for example, requesting for stopping transmission of electromagnetic waves. *(See, Specification, page 10, lines 7-12).* However, it is possible to perform certain operations, such as viewing received information and preparing email information, which do not require transmission of electromagnetic waves. *(See, Specification, page 10, lines 13-16).*

Therefore, an object of the present invention is to provide capability of stopping transmission functions of electromagnetic waves while maintaining information processing functions of a portable information apparatus, such as a cellular phone. *(See, Specification, page 3, lines 11-19).* Moreover, another object of the present invention is to reduce the influence to other devices, such as cardiac pace makers, that can fail under strong ambient electromagnetic waves in specific places and/or facilities, such as public places and/or facilities. *(See, Specification, page 4, lines 14-23).*

The present invention is directed to a portable information apparatus having communications tools. The portable information apparatus includes a wireless

transmission/reception section for transmitting to and receiving from an external wireless transmitter/receiver electromagnetic signals. An operation section performs various operations. A display section displays status of the operations made by the operation section. A display section displays status and results of transmission/reception operations made by the wireless transmission/reception section. A control section connected with the wireless transmission/reception section, operation section, and display section controls the overall actions of the portable information apparatus. The portable information apparatus includes a reception means, within or outside the wireless transmission/reception section, for receiving a communication prohibition signal and/or a communication permission signal transmitted from an external facility. Reception means further provides for enabling/disenabling the transmission functions of the wireless transmission/reception section upon receipt of the communication prohibition signal and/or the communication permission signal.

The portable information apparatus, such as cellular phones, are configured to transmit electromagnetic waves not only for communication with a relay station (base station) to talk with partners but also for period registration of their current locations at the base station so that the apparatuses can receive telephone calls and e-mail. As a result of dissemination of such portable information apparatuses, strong electromagnetic waves are emitted everywhere for communications, thereby posing serious problems to device such as cardiac pace-makers that can fail under strong ambient electromagnetic waves. Therefore, an object of the invention to be capable of stopping transmission functions of electromagnetic waves while maintaining information processing functions of which a portable information apparatus, such as cellular phones have, in the specific places, such as public facilities. *(See Specification, page 10, lines 7-16).*

In one aspect, the wireless transmission/reception section can be adapted to serve as a dedicated wireless receiver when the transmission functions of the wireless transmission/reception section are disenabled. *(See Specification, page 10, lines 17-22).*

In another aspect, the communication prohibition signal and/or the communication permission signal are/is weaker than the electromagnetic waves transmitted from the wireless transmission/reception section of the portable information apparatus. *(See Specification, page 12, lines 11-18).*

Since the communication prohibition signal and/or the communication permission signal are/is weaker than the electromagnetic wave transmitted from the wireless transmission/reception section of the portable information apparatus, the communication prohibition signal and/or the communication permission signal have/has little effect on the apparatuses that can easily go wrong or malfunction under strong ambient electromagnetic waves. *(See Specification, page 5, lines 8-13).*

In still another aspect, the portable information apparatus further includes a data section and a discrimination section. The data section stores data regarding the portable information apparatus. The discrimination section is adapted to receive the results of the reception from the reception means and receive data from the data section. The discrimination section sets the transmission function of the wireless transmission/reception section enabled or disenabled based on the results received from the reception means and the data received from the data section. *(See Specification, page 12, line 19 to page 13, line 2).*

The portable information apparatus having the communication tools may effect appropriate control of the communications tools by determining whether the transmission functions of the wireless transmission/reception section must be enabled/disenabled based on the limitations comprised in the communication prohibition signal and/or the communications permission signal received from the

external facility and the data regarding the portable information apparatus. *(See Specification, page 5, line 23 to page 6, line 2).*

The present invention is also directed to a control system for controlling portable information apparatuses having communications tools. The control system includes a transmitter for transmitting a communication prohibition signal and/or a communication permission signal to the portable information apparatuses. The transmitter installed at a location where transmissions of electromagnetic waves from said portable information apparatuses are prohibited. The communication prohibition signal and/or communication permission signal are/is weaker than electromagnetic waves transmitted from the wireless transmission/reception section of the portable information apparatus. The transmitter is operated under predetermined conditions. The control system may include a multiplicity of transmitters. *(See Specification, page 15, line 4 to page 16, line 16).*

The transmission functions of the portable information apparatuses, when brought to a congested location, such as a train, bus, and stations, or in an educational facility where transmission of electromagnetic waves is prohibited, are automatically stopped by a communication prohibition signal and/or the communication permission signal transmitted from the control system installed at the site, thereby not influencing other people with electromagnetic waves. Even then the carrier of a portable information apparatus can still perform ant processes other than transmission by means of the portable information apparatus. *(See Specification, page 6, lines 10-18).*

The present invention is also directed to an apparatus equipped with a controller for controlling portable information apparatuses having communications tools. The apparatus includes a transmitter for transmitting a communication prohibition signal and/or a communication permission signal to the portable information apparatuses. The transmitter is installed on an apparatus that can be

influenced by electromagnetic waves transmitted from the portable information apparatuses. The communication prohibition signal and/or the communication permission signal are/is weak enough not to influence the electromagnetically susceptible apparatus. *(See Specification, page 16, line 17 to page 17, line 8).*

The apparatus transmits the communication prohibition signal and/or the communication permission signal from the transmitter, which is installed on the electromagnetically susceptible apparatus, such as a medical device including a cardiac pacemaker and airplane that can be influenced by electromagnetic waves transmitted from the portable information apparatuses. Thus, the transmission functions of portable information apparatuses approaching medical devices or on board the airplane having such transmitters are automatically turned off so as to not influence other apparatuses. However, the carriers of the portable information apparatuses can still perform other localized operations that do not involve transmission of electromagnetic waves. *(See Specification, page 7, line 21 to page 8, line 3).*

ISSUES

There is one issue on Appeal:

I. Whether the Final Office Action dated July 7, 2004 ("Final Office Action") properly rejects Claims 3-12 under 35 U.S.C. §102(e) over U.S. Pat. App. Pub. No. 2001/0031631 A1 to Pitts ("Pitts").

GROUPING OF CLAIMS

The rejected claims stand or fall together.

ARGUMENT

I. Rejection of Claims 3-12.

Applicant respectfully submits that Pitts does not anticipate or render obvious Claims 3-12. In particular, the applied Pitts reference does not disclose or

suggest a portable information apparatus having a reception means "for receiving a communication prohibition signal and/or a communication permission signal transmitted from an external facility," as required by independent Claim 3. Moreover, the applied Pitts reference does not disclose or suggest a portable information apparatus having a reception means "for enabling/disenabling said transmission functions of said wireless transmission/reception section upon receipt of said communication prohibition signal and/or said communication permission signal," as required by independent Claim 3.

The Final Office Action purports, on page 4, that Pitts discloses a reception means for receiving a communication prohibition signal and/or a communication permission signal, where "deactivate" and "re-enable" are prohibition and permission signals. However, the object of Pitts is to keep personal communication devices, such as cellular phones, from ringing, to limit the audible communications using personal communication devices, and to allow silent communications in a limited range where the silence should be kept, such as in a music hall or court. *(See, Pitts, Page 3, paragraphs 45-54).*

Pitts is specifically directed to deactivating audible signals while still allowing the transmission of electromagnetic waves for silent communication between communication devices in place of audible communications. *(See, Pitts page 3, paragraphs [0044]-[0048]).* Pitts allows the transmission of electromagnetic waves for silent communication where incoming messages can be still received via the transmission of electromagnetic waves and responded to a silent communication with the transmission of text messages via electromagnetic waves. According to Pitts, communications, including the transmission of electromagnetic waves, are continuously allowed without interruption, which means that communications between personal communication devices via electromagnetic waves are not being stopped as required by the claims of the present invention. Clearly, Pitts is not

concerned with enabling or disenabling transmission of electromagnetic waves or enabling or disenabling any transmission or communication functions.

In contrast, the object of the present invention is directed to stopping communications, including transmission functions of electromagnetic waves, while maintaining information processing functions of a portable information apparatus, such as a cellular phones. Another object of the present invention is directed to reducing the influence of portable information apparatus have on other devices, such as cardiac pace makers, that can fail under strong ambient electromagnetic waves in the places, such as public facilities. Pitts fails to disclose or suggest these features of the present invention as required by the claims.

When ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole (MPEP 2141.02). Accordingly, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

In rejecting Claims 3-12 over Pitts, the Office Action purports that Pitts discloses a reception means for receiving a communication prohibition signal and/or a communication permission signal, where "deactivate" and "re-enable" are prohibition and permission signals. (See, Final Office Action, page 4, line 15 to page 5, line 5). However, the invention of Pitts is to limit audible sound generation of personal communication devices, such as cellular phones. Pitts continuously allows transmission of electromagnetic waves during "silent communications". Therefore, the invention of Pitts does not stop transmission functions including transmission of electromagnetic waves. Pitts merely stops the audible signals, but continually allows the transmission of communication signals including the transmission of electromagnetic waves between communication devices.

To anticipate a claim, the reference must teach every element of the claim (MPEP 2131).

A claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

According to Pitts, a personal communication device, such as a cellular phone, has communication functions including silent communication where the user is alerted of incoming calls and messages are sent using a keypad. When messages are sent, transmission functions of electromagnetic waves are being allowed during this silent communication mode, which means that transmission functions of electromagnetic waves are not being topped. Accordingly, with Pitts, during silent communication, the cellular phone receives incoming calls. The phone notifies the user of receiving incoming calls by vibration, a blinking display, or other silent means. If the call is answered, incoming audible messages will be routed to an earpiece and keypad entries will be transmitted to another communications device and outgoing messages are sent or transmitted as requested by keypad. *(See, Pitts, page 3, paragraphs [0044]-[0048]).*

In contrast, the present invention discloses a portable information apparatus having a reception means "for receiving a communication prohibition signal and/or a communication permission signal transmitted from an external facility," as required by independent Claim 3. Moreover, the present invention discloses a portable information apparatus having a reception means "for enabling/disenabling said transmission functions of said wireless transmission/reception section upon

receipt of said communication prohibition signal and/or said communication permission signal," as required by independent Claim 3.

Since the applied Pitts reference does not disclose or suggest each and every limitation recited in independent Claim 3, this reference cannot be said to anticipate nor render obvious the invention which is the subject matter of that claim. Accordingly, independent Claim 3, as originally filed, is believed to be in condition for allowance and such allowance is respectfully requested.

Applicant respectfully submits that independent Claims 7 and 11, as originally filed, are similarly allowable for at least some of the same reasons discussed above in connection with independent Claim 3.

The remaining claims depend either directly or indirectly from amended independent Claims 3, 7 and 11 and recite additional features of the invention which are neither disclosed nor fairly suggested by the applied references and are therefore also believed to be in condition for allowance.

The present Brief is submitted herewith in triplicate along with an Appendix containing the appealed claims and the requisite brief fee.

Respectfully submitted,
HOGAN & HARTSON L.L.P.

Date: April 11, 2005

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APPENDIX: CLAIMS 1-12 ON APPEAL

1-2. (Cancelled).

3. (Original) A portable information apparatus having communications tools, said portable information apparatus including:

a wireless transmission/reception section for transmitting to and receiving from an external wireless transmitter/receiver electromagnetic signals;

an operation section for performing various operations;

a display section for displaying status of the operations made by said operation section, and status and the results of transmission/reception operations made by said wireless transmission/reception section; and

a control section connected with said wireless transmission/reception section, operation section, and display section, for controlling overall actions of said portable information apparatus,

said portable information apparatus further comprising reception means, within or outside said wireless transmission/reception section, for receiving a communication prohibition signal and/or a communication permission signal transmitted from an external facility, and for enabling/disenabling said transmission functions of said wireless transmission/reception section upon receipt of said communication prohibition signal and/or said communication permission signal.

4. (Original) The portable information apparatus having communications tools according to claim 3, wherein said wireless transmission/reception section is adapted to serve as a dedicated wireless receiver when said transmission functions of said wireless transmission/reception section are disenabled.

5. (Original) The portable information apparatus having communications tools according to claim 3, wherein said communication prohibition signal and/or said communication permission signal are/is weaker than the electromagnetic waves transmitted from said wireless transmission/reception section of said portable information apparatus.

6. (Original) The portable information apparatus having communications tools according to claim 3, further comprising:

a data section for storing data regarding the portable information apparatus;

a discrimination section, adapted to receive the results of the reception from the reception means and receive data from the data section, for setting the transmission function of the wireless transmission/reception section enabled or disenabled, based on the results received from the reception means and the data received from the data section.

7. (Original) A control system for controlling portable information apparatuses having communications tools, said control system having a transmitter for transmitting a communication prohibition signal and/or a communication permission signal to the portable information apparatuses, said transmitter installed at a location where transmissions of electromagnetic waves from said portable information apparatuses are prohibited.

8. (Original) The control system according to claim 7, wherein said communication prohibition signal and/or communication permission signal are/is weaker than electromagnetic waves transmitted from the wireless transmission/reception section of the portable information apparatus.

9. (Original) The control system according to claim 7, wherein said transmitter is operated under predetermined conditions.

10. (Original) A control system comprising a multiplicity of transmitters defined in claim 7.

11. (Original) An apparatus equipped with a controller for controlling portable information apparatuses having communications tools, said apparatus comprising a transmitter for transmitting a communication prohibition signal and/or a communication permission signal to said portable information apparatuses, wherein said transmitter is installed on an apparatus that can be influenced by electromagnetic waves transmitted from said portable information apparatuses.

12. (Original) The apparatus equipped with a controller according to claim 11, wherein said communication prohibition signal and/or said communication permission signal are/is weak enough not to influence said electromagnetically susceptible apparatus.